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REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Claims 1 and 3-10 were pending in the instant application at the time of the outstanding Office Action. Of these claims, Claims 1, 5, 7, and 10 are independent claims; the remaining claims are dependent claims. Per the outstanding Office Action, the pending claims were rejected and the rejection was made final.

As set forth in the present listing of claims and discussed below, the independent claims have been amended. Applicants respectfully submit no new matter has been added by the present amendment. Support for the amendment can be found generally throughout the text. It should also be noted this amendment is not in acquiescence of the Office's position on the allowability of the claims, but made merely to expedite prosecution.

Applicants also note a Request for Continued Examination is being filed herewith so as to allow for the furtherance of the prosecution of the application. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

REJECTIONS UNDER 35 U.S.C. 102

I. Tateishi et al.

Claims 1, 4, 8 and 9 stand rejected under 35 U.S.C. 102(b) as being anticipated by Tateishi et al., EP-A 677 246, hereinafter referred to as "Tateishi". Applicants respectfully traverse the rejections.

As best understood, the Tateishi reference discloses fungicidal compositions that target microorganisms having resistance to benzimidazole fungicides. Such

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compositions may include benomyl, cypendazole, carbendazim, EBC, thiabendazole, fuberidazole, dimethbenzazol, thiophanate methyl, and thiophanate with ipconazole. As opined by the Office, Tateishi also teaches compositions including "triflumizole," an imidazole, thereby teaching the claimed invention.

As presently amended, independent Claim 1 recites, *inter alia*, "[i]midazoles selected from the group consisting of clotrimazole, climbazole, imazalil, ketoconazole, prochloraz, and their metal salts and acid adducts."

It is therefore respectfully submitted that even if Tateishi teaches a composition including triflumizole, the same fails to teach the presently claimed specific group of imidazoles. Thus Tateishi fails to anticipate the presently claimed invention, because at the very least, "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under construction." *W.L. Gore & Associates, Inc. v. Garlock*, 721 F.2d 1540, 1554 (Fed. Cir. 1983); *see also In re Marshall*, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

In light of the above, the withdrawal of the present 35 U.S.C. 102 rejections of Claims 1, 4, 8, and 9 is appropriate at this juncture and respectfully requested.

II. Schelberger et al.

Claims 1 and 3-10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Schelberger et al., USPN 6,369,090, hereinafter referred to as "Schelberger". Applicants' respectfully traverse the rejections.

As best understood, Schelberger appears to disclose fungicidal mixtures including active compounds selected from the following classes: a) carbamates; b) morpholines; and c) azol fungicides. One azole fungicide of Schelberger et al. appears to be ipconazole.

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The claims as presently amended no longer include the language "morpholine derivatives." Independent Claims 1, 5, 7, and 10 currently recite, *inter alia*, "[d]odemorph and its salts with arylsulphonic acids...." Support for the amendment can be found on page 3, line 19 of Applicants' disclosure. It is respectfully submitted that dodemorph, which corresponds to 4-Cyclododecyl-2,6-dimethylmorpholin, does not fall within the scope of the formulae b.1) or b.2) of the morpholine derivatives as taught by Schelberger et al.

In addition, the independent claims have been amended to recite, *inter alia*, "[i]odine derivatives selected from the group consisting of diiodomethyl-p-tolyl sulphone and 3-iodo-2-propynyl n-butylcarbamate...." It is respectfully submitted that the carbamates as set forth in formula a.1) of the Schelberger reference fail to teach the presently claimed iodine derivatives.

In light of the present amendments, Schelberger fails to anticipate the presently claimed invention because, as indicated above, "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under construction." *W.L. Gore & Associates, Inc. v. Garlock*, 721 F.2d 1540, 1554 (Fed. Cir. 1983); *see also In re Marshall*, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

For the aforementioned reasons the withdrawal of the present 35 U.S.C. 102 rejections of Claims 1 and 3-10 is appropriate at this juncture and respectfully requested.

REJECTIONS UNDER 35 U.S.C. 103

Claims 1 and 4-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tateishi in view of Arahira et al., EP-A 341 954, hereinafter referred to as "Arahira".

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As the learned Examiner is assuredly aware, "in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claims limitations. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicants' disclosure." *See MPEP* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d. 1438 (Fed. Cir. 1991)).

As rightly indicated by the Examiner, Tateishi fails to disclose the application of the fungicidal compositions set forth therein to industrial materials including wood, wood-based materials, plastics, cooling lubricants and coating systems, such as paints, varnishes or plaster. (Office Action P. 6) The Office finds, however, that Arahira discloses the use of biocidal compositions containing an azole derivative for preventing the deterioration of industrial materials including paper, lumber, leather, paints, plastics, metals and inorganic materials and products formed by these materials. Furthermore, the Office opines that in light of these two references it would have been obvious for skilled artisan to use the composition of Tateishi to protect industrial materials and that such a combination produces the instant invention.

With respect to Claims 1, 4, 8, and 9 it should first be indicated that, as discussed above, Tateishi clearly fails to teach or suggest "[i]midazoles selected from the group consisting of clotrimazole, climbazole, imazalil, ketoconazole, prochloraz, and their metal salts and acid adducts." (Claim 1) Moreover, Arahira fails to overcome this deficiency; therefore, the withdrawal of these obviousness rejections is immediately proper because the combination of references fails to teach all of the limitations of the presently claimed invention.

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With respect to all of the claims rejected under 35 U.S.C. 103 the Applicants would like to offer the following remarks for the Examiner's reconsideration of these rejections. It should be noted Applicants' previous remarks remain applicable to the present rejections and are hereby incorporated by reference.

With respect to the present invention and in contrast to Tateishi and Arahira it was unexpectedly and surprisingly found that the microbicidal properties of ipconazole can be improved and synergistically enhanced by mixing ipconazole with other specific active compounds capable of providing protection to nonliving technical materials. The claimed embodiments are importantly characterized by a synergistically increased activity against microorganisms that destroy technical materials. These properties are completely unexpected and could not have been foreseen by in light of the disclosures of the prior art references.

Moreover, as has been previously discussed, technical materials and living materials are simply different from one another even though they are perhaps formed of similar material and, therefore, the skilled artisan generally accepts that a composition suitable for the protection of living materials, e.g. plants, normally is not used for combating microorganisms that destroy technical materials, e.g. lumber, and vice versa. This understanding is partially based on the fact the microorganisms that attack living plants are normally different from those that attack technical nonliving materials such as wood and wooden materials. Thus a microbicide that is suitable for the protection of plants is created to meet and satisfy different purposes and requirements as compared with a microbicide that is suitable for the protection of technical materials.

In light of the differences between living and nonliving materials, along with the differences in the compositions those skilled in the art would normally consider in view of the material to be protected, Applicants respectfully submit one skilled in the art would neither be motivated to combine the references nor would there be an

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expectation of success that the invention produced by the combination could be used as is presently claimed. In other words, the skilled artisan who wanted to improve the efficacy of the known ipconazole for the protection of technical materials would not have combined ipconazole with a compound that was known to protect plants. Accordingly, one skilled in the art would not be motivated to combine the teachings of Tateishi with the teaching of Arahira. Reconsideration is therefore again requested.

In view of the foregoing, it is respectfully submitted that independent claims 1, 5, 7, and 10 fully distinguish over the applied art and are thus are in condition for allowance. By virtue of dependence from what are believed to be allowable independent Claims 1 and 5, it is respectfully submitted that Claims 3, 4, 6, 8, and 9 are also presently allowable.

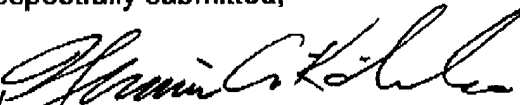
The "prior art made of record" has been reviewed. Applicants acknowledge that such prior art was not deemed by the Office to be sufficiently relevant as to have been applied against the claims of the instant application. To the extent that the Office may apply such prior art against the claims in the future, Applicants will be fully prepared to respond thereto.

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In summary, it is respectfully submitted that the instant application, including Claims 1 and 3-10, is presently in condition for allowance. Notice to the effect is earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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